

**REMARKS**

Claims 1, 2 and 5-20 are all the claims pending in the application.

**Obviousness Rejection**

On page 2 of the Office Action, claims 1, 2, and 5-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furukawa (6,569,602) in view of Arias et al (6,933,093).

**The Examiner's Position**

The Examiner's position with respect to Furukawa and Arias is the same as that set forth in the Office Action of February 24, 2006.

With respect to the arguments set forth in the Amendment filed November 13, 2006 in response to the August 10, 2006 Office Action, the Examiner indicates that they are not persuasive because Tutt has been relied upon solely for its teaching of an overcoat layer for a thermally sensitive polymeric layer, not for the entire material. The Examiner indicates that since the overcoat is known to be employed in similar applications, it would have been obvious to use the known overcoat of Tutt in the material of Oshima.

**Applicant's Response**

In response to this rejection, Applicant notes initially that the Final Office Action apparently contains an error, namely, the rejection that is set forth (Furukawa in view of Arias) is the rejection from the February 24, 2006 Office Action, not the rejection from the August 10, 2006 Office Action (Oshima in view of Tutt and Muller).

Since the rejection that is set forth was previously overcome by the arguments set forth in response filed May 24, 2006 (see the top of page 2 of the August 10, 2006 Office Action),

Applicant directs the Examiner's attention to the arguments that were presented in the response filed May 24, 2006, and submits that the rejection should be withdrawn accordingly.

Further, if the previous rejection over Oshima in view of Tutt and Muller is to be maintained, Applicant respectfully requests a new Office Action.

Also, Applicant notes that what is disclosed in paragraph [0036] of Muller et al. (EP 1 249 343 A2) is a list of examples of polycarboxylic amino-acids or imino-acids. The reference neither teaches nor suggests the compounds described in the present invention (i.e., phthalic acid and derivatives thereof, trimellitic acid and derivatives thereof, pyromellitic acid and derivatives thereof, succinic acid and derivatives thereof, and benzoic acid and derivatives thereof). Thus, Applicant submits that the rejection over Oshima in view of Tutt and Muller should not be maintained.

In addition, Applicant notes that Tutt et al. (USP No. 5,985,526) discloses a thermal recording element, and an overcoat layer that may contain a UV absorber to prevent dye degradation. However, Tutt discloses a thermal recording element that could be used as a mask placed over a printing plate -- the thermal recording element cannot be used as a printing plate itself. Thus, one of ordinary skill in the art would not apply Tutt's teaching of an overcoat layer containing a UV absorber to Oshima's protective layer. Accordingly, Applicant submits that there is no motivation to combine the two references.

Due to the difference in the technological field, the effect of containing a UV absorber in Tutt is completely different from that of the present invention. Applicant submits that one with ordinary skill in the art would not think of using the UV absorber disclosed in Tutt to improve

the handling property of a planographic printing plate exposed by infrared laser light under white light and safelight.

Finally, Applicant notes that the Examiner has not commented on the argument with respect to claim 20 that Muller's paragraph [0036] noted by the Examiner neither teaches nor suggests a phthalic acid derivative, a trimellitic acid derivative, a pyromellitic acid derivative, or a succinic acid derivative as specifically recited in that claim (see page 7, lines 8-13 in the November 13, 2006 Amendment), so Applicant requests the Examiner's specific response to that argument.

#### **PTO-892 Form**

Applicant notes that a blank PTO-892 form was attached to the Office Action. Since no new references have been cited by the Examiner, Applicant considers that the PTO inadvertently attached this form to the Office Action. However, if one or more new references were intended to be cited, the Examiner is requested to include those citations in the next communication from the PTO.

#### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116  
U.S. Application No. 10/779,788

Attorney Docket No. Q79792

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

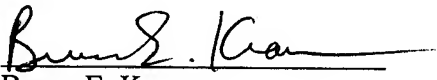
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**23373**

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